

Docket 86631EIS  
Customer No. 01333

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Steven M. Bryant

METHOD SYSTEM OF  
SOFTWARE FOR PUBLISHING  
IMAGES ON A PUBLICLY  
AVAILABLE WEBSITE AND FOR  
ORDERING OF GOODS OR  
SERVICES

Serial No. 10/748,107

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Mail Stop APPEAL BRIEF-PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Group Art Unit: 3625

Examiner: Resha Desai

Confirmation No. 6924

Sir:

**APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134**

## **Table Of Contents**

<b><u>Table Of Contents</u></b> .....	i
<b><u>Real Party In Interest</u></b> .....	1
<b><u>Related Appeals And Interferences</u></b> .....	1
<b><u>Status Of The Claims</u></b> .....	1
<b><u>Status Of Amendments</u></b> .....	1
<b><u>Summary of Claimed Subject Matter</u></b> .....	2
<b><u>Grounds of Rejection to be Reviewed on Appeal</u></b> .....	4
<b><u>Arguments</u></b> .....	5
<b><u>Summary</u></b> .....	13
<b><u>Conclusion</u></b> .....	13
<b><u>Appendix I - Claims on Appeal</u></b> .....	14
<b><u>Appendix II - Evidence</u></b> .....	22
<b><u>Appendix III – Related Proceedings</u></b> .....	23

## **APPELLANT'S BRIEF ON APPEAL**

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-11, which was contained in the Office Action mailed August 31, 2009.

A timely Notice of Appeal was filed, December 29, 2009, which was received in the USPTO on December 29, 2009.

### **Real Party In Interest**

The Eastman Kodak Company is the real party in interest.

### **Related Appeals And Interferences**

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

### **Status Of The Claims**

Claims 1- 20 and 22 are pending in the application. Claim 21 has been canceled. All the pending claims have been rejected. Claims 1-11 are being appealed.

Appendix I provides a clean, double spaced copy of all the claims involved.

### **Status Of Amendments**

Subsequent to final rejection, no amendment has been filed.

### **Summary of Claimed Subject Matter**

With respect to claim 1, the claimed invention is directed to a method for publishing images at a web site, see FIG. 1, element 16. The web site is accessible over a communication network, see FIG. 1, element 14. The method also includes ordering goods and/or services from a fulfillment provider, see FIG. 1, element 20, that is also coupled to the communication network. The goods and/or services pertain to images stored at the fulfillment provider and may include, for example, printing a 4×6 print of an image, see FIG. 7. All of the above features of the invention are discussed at least at page 4, line 28 through page 5, line 13 of the present patent application.

The fulfillment provider receives a high resolution digital image over the communication network from a user device, see FIG. 1, element 12, that is coupled to the communication network. This step is described at least at page 5, lines 14 through 30, and in FIG. 2, step 44.

The fulfillment provider stores the high resolution digital image and associates a unique identifier ("ID") with the image, wherein the ID is used to identify both a storage location of the high resolution image and an internet address of the fulfillment provider. This step is described at least at page 5, line 27, through page 6, line 7 and in FIG. 2, step 44.

This ID is then forwarded over the communication network to the user device, as described at least at page 5, lines 30-32 and in FIG. 2, step 46, and in FIG. 5.

The website receives a low resolution copy over the communication network, from the user device, of the high resolution image (which is stored at the service provider) and also receives the ID from the user device, as described at page 6, lines 8-22.

The web site then provides the low resolution image over the communication network and an action button (which can be compared to a hyper-link) associated with the ID, as described at page 6, lines 23-25, and in FIG. 6.

When a viewing device that is connected to the network selects the action button (provided by the web site), the fulfillment provider forwards an order screen to the viewing device so that the viewing device can place an order over the communication network, directly with the fulfillment provider, for goods and/or services with respect to the high resolution image that is stored at the fulfillment provider, as described at page 6, line 30 - page 7, line 9; FIG. 3, steps 76 and 80; and in FIG. 7.

Each of the recited elements "fulfillment provider," "user device," "website," "viewing device," and "communication network" is illustrated

in operative relationship in FIG. 1 as elements 20, 12, 16, 18, and 14, respectively.

**Grounds of Rejection to be Reviewed on Appeal**

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 1-4, and 9 are obvious under 35 U.S.C. 103(a) over Shiimori et al., U.S. Patent Application Publication No. US 2002/0091766 ("Shiimori") in view of McIntyre, U.S. Patent Application Publication No. US 2003/0007200 ("McIntyre").

2. Whether claim 5 is obvious under 35 U.S.C. 103(a) over Shiimori in view of McIntyre, and further in view of Wang et al., U.S. Patent No. 6,058,428 ("Wang").

3. Whether claim 6 is obvious under 35 U.S.C. 103(a) over Shiimori in view of McIntyre, and further in view of Robinson et al., U.S. Patent Application Publication No. US 2002/0065844 ("Robinson").

4. Whether claims 7, 8, and 11 are obvious under 35 U.S.C. 103(a) over Shiimori in view of McIntyre, and further in view of Bernius et al., JP Publication number 2003-141024 ("Bernius").

5. Whether claim 10 is obvious under 35 U.S.C. 103(a) over Shiimori in view of McIntyre, and further in view of Patton et al., U.S. Patent No. 6,408,301 ("Patton").

### **Arguments**

**ISSUE No. 1 Shiimori in view of McIntyre does not render obvious the inventions as set forth in claims 1 - 4, and 9.**

With respect to the first claim element of claim 1: "said fulfillment provider receiving a high resolution digital image from a user device over the communication network, the user device coupled to the communication network," Shiimori states in paragraph [0065]: "The 'contributed image management function' is a function for managing images contributed by contributors registered in the image sharing server 40 to planned pages selected by the contributors according to their preferences." From paragraph [0061] in Shiimori it is stated that the planned pages are located at server 40: "Each planner sets up an original planned page on the image sharing server 40, and develops a service based on widely accepting contributed images from the network,

releasing the contributed images on the planned page, and selling the images to third parties." Hence, based on FIG. 1 of Shiimori, Contributor 20 sends images to server 40. Based on the language of the present claim and on the Examiner's interpretation of Shiimori as stated on page 6 of the Final Rejection, Shiimori's Contributor 20 is equated with the claimed "user device" and Shiimori's server 40 is equated with the claimed "fulfillment provider."

With respect to the second claim element of claim 1: "said fulfillment provider storing said high resolution digital image including associating a unique ID with said high resolution digital image, said unique ID identifying both a storage location of said high resolution digital image and an internet address of the fulfillment provider," in paragraph [0085] Shiimori states: "The image sharing server 40 receives and registers the contributor information and issues individual identification information for identification of the contributor (contributor ID) . . ." and in paragraph [0093] Shiimori states: "The image sharing server 40 stores in the contributor ID folder the contributed image sent from the contributor and registers certain sorts of information in a contributed image management table (step S309). FIG. 10 shows the composition of the contributed image management table (table 6)." Hence, based on FIG. 10 of Shiimori which shows management table



entries, including a Contributor ID, and based on the Examiner's interpretation Shiimori as stated on page 6 of the Final Rejection, the *image location* in Shiimori's management table is equated with Applicant's claimed ID, and Shiimori's *image location* identifies a storage location of the image as described in FIG 10 therein. However, Shiimori's *image location* must also identify an internet address of the server 40 (fulfillment provider) according to this element of claim 1. Nowhere does Shiimori describe that the image location entry in the management table provides these data as claimed, in particular, the internet address of the server 40. Therefore, Shiimori does not provide a proper basis for rejecting claim 1 under 35 U.S.C. 103(a). Both of these claimed elements are necessary for the proper operation of Applicant's invention. The internet address is necessary for communicating with the fulfillment provider over the network and the storage location is necessary for the fulfillment provider to retrieve the high resolution digital image from storage at the fulfillment provider, as explained in Applicant's patent application at least at page 6, lines 12-20, and page 7, lines 14-25.

With respect to the third claim element of claim 1: "forwarding said unique ID over the communication network to said user device," Shiimori states in paragraph [0088]: "The contributor PC 20 receives the

notified contributor ID from the image sharing server 40 (step S205)".

Based on the discussion above with respect to the second claim element and based on the Examiner's interpretation of this third claim element as stated in the Final Rejection on page 6, Shiimori's server 40 forwards the contributor ID to the contributor PC 20. The contributor ID is not equated by the Examiner to Applicant's claimed ID. The examiner could not make this comparison because Shiimori's contributor ID clearly does not include an image location nor does it include an internet address of the server 40. As explained above with respect to the second claimed element, the Examiner has equated Shiimori's *image location* with Applicants claimed ID. Shiimori's *image location* defines a storage location of an image. However, as is plainly described in Shiimori, the *image location* is not forwarded to the contributor PC 20, and the Examiner has not asserted that it is forwarded to the contributor PC 20. Therefore, Shiimori fails to mention this step of claim 1 and, for a second reason, Shiimori does not provide a proper basis for rejecting claim 1 under 35 U.S.C. 103(a).

With respect to the fourth claim element of claim 1: "said website receiving over the communication network from said user device a low resolution image copy of said high resolution image and said unique ID," there is no comparable description in Shiimori. Based on the Examiner's

interpretation of this fourth claim element as stated in the Final Rejection on page 6, Shiimori's FIG. 18 and its corresponding description, at least in paragraphs [0147] - [0151], allegedly provide a basis for rejecting claim 1 under 35 U.S.C. 103(a). There is no mention in Shiimori of contributor PC 20 (the claimed "user device") sending the *image location* data to a website. In particular, as explained above with respect to the third claim element, Shiimori never describes the contributor PC as having the *image location* data in the first place because server 40 never sends the *image location* data to the contributor PC—it only sent the contributor ID which does not contain image location data. Therefore, contributor PC could not send image location data because it never has the *image location* data. As described in Shiimori's paragraphs [0147] - [0151], the display shown in FIG. 18 therein illustrates a computer display that is triggered when a camera (FIG. 17 element 160) is inserted into a computer-connected cradle (FIG. 17 element 162). The display 170 then shows the camera file folders in file list 173 and images 174 from a selected camera folder. Internet related messages and/or buttons 171 in right hand display column 176 show services available over the internet that may be requested for the images in the camera. None of the menu buttons 171 in right hand column 176 of the display can be reasonably interpreted as containing a low resolution copy of the high

resolution image at the server 40 nor can these menu buttons be reasonably interpreted as containing *image location* data for the high resolution image such as required by claim 1. It is clear that FIG. 18 is unrelated to this fourth element of claim 1 and to the entire claim 1, in general. Therefore, for a third reason, Shiimori does not provide a proper basis for rejecting claim 1 under 35 U.S.C. 103(a).

With respect to the fifth claim element of claim 1: "said website providing over the communication network said low resolution image along with an action button that is associated with said unique ID," Shiimori's FIG. 18 is unrelated to this claim element for the same reasons as explained above with respect to the fourth claim element (no low resolution image or image location data associated with it is provided by a website). Therefore, for at least a fourth reason, Shiimori does not provide a proper basis for rejecting claim 1 under 35 U.S.C. 103(a).

With respect to the sixth, and final, claim element of claim 1: "forwarding to a network connected viewing device over the communication network an order screen from said fulfillment provider when said action button is selected by said viewing device so that the viewing device will be able to place an order over the communication network directly with said fulfillment provider for goods and/or services with respect to said high resolution image stored by said fulfillment

provider", Shiimori's FIG. 18 and its related description defines menu buttons provided in the right hand column 176 of viewer 170. However, FIG. 18 and its related description in paragraphs [0147] - [0151] do not define any of these menu buttons to have associated with it an *image location* of the high resolution image, which "high resolution image" is recited in the first element of claim 1, so that the viewing device can place an order with the fulfillment provider for that particular image. In fact, Shiimori's description of the systems shown in FIG. 18 and FIG. 1, as referenced in Applicant's preceding explanations, makes it doubtful that these Figures are related at all. These two disparate Figures in Shiimori are not operationally linked and so cannot serve as a basis for rejecting claim 1 under 35 U.S.C. 103(a). Therefore, for at least a fifth reason, Shiimori does not provide a proper basis for rejecting claim 1 under 35 U.S.C. 103(a).

The Examiner states that McIntyre teaches "a fulfillment provider (element 70) receiving a high resolution digital image from a user device over a communication network (element 50)" and that "said image" of claim 1 will be referring to the high resolution digital image of McIntyre. Assuming, *arguendo*, that McIntyre's digital image can be referred to as "said image" of claim 1, McIntyre neither links together the disparate operations of the systems of Figs. 1 and 18 in Shiimori, nor remedies the

deficiencies of Shiimori as explained in detail above with respect to the second, third, fourth and fifth elements of claim 1.

Claims 2-4, and 9:

It is respectfully submitted that further consideration of claims 2-4, and 9 rejected under 35 U.S.C. 103(a), upon the citing of Shiimori and McIntyre is moot, inasmuch as these prior arts lack any teaching, disclosure, or suggestion concerning the elements of claim 1 as described in detail above.

Because Shiimori and McIntyre fail to provide grounds for the rejection of claim 1 under 35 U.S.C. 103(a), as presented above, claims 2-4, and 9 are also allowable over Shiimori and McIntyre.

**ISSUE Nos. 2-5. Wang, Robinson, Bernius, and Patton do not add substantive teachings to Shiimori or McIntyre that would render dependent claims 5, 6, 7, 8, 10, and 11 obvious under 35 U.S.C. 103(a).**

It is respectfully submitted that further consideration of claims 5, 6, 7, 8, 10, and 11, rejected under 35 U.S.C. 103(a), upon the citing of Shiimori and McIntyre is moot, inasmuch as the inclusion of Wang, Robinson, Bernius, and Patton as prior art still lack any teaching,

disclosure, mention, or suggestion concerning the elements of claim 1 as described in detail above.

**Summary**

In summary, Applicant respectfully submits that the presently appealed claims are patentably distinct over the cited prior art.

**Conclusion**

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1-11.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Eugene I. Shkurko', is written over a horizontal line.

Eugene I Shkurko/ct  
Telephone: 585-523-0123  
Facsimile: 585-477-1148  
Enclosures

Eugene I. Shkurko  
Attorney for Appellant(s)  
Registration No. 36,678

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

## **Appendix I - Claims on Appeal**

1. (Previously Presented) A method for publishing images at a website coupled to a communication network and for ordering goods and/or services to be provided by a fulfillment provider coupled to the communication network with respect to images stored at said fulfillment provider, comprising the steps of:

said fulfillment provider receiving a high resolution digital image from a user device over the communication network, the user device coupled to the communication network;

said fulfillment provider storing said high resolution digital image including associating a unique ID with said high resolution digital image, said unique ID identifying both a storage location of said high resolution digital image and an internet address of the fulfillment provider;

forwarding said unique ID over the communication network to said user device;

said website receiving over the communication network from said user device a low resolution image copy of said high resolution image and said unique ID;



said website providing over the communication network said low resolution image along with an action button that is associated with said unique ID; and

forwarding to a network connected viewing device over the communication network an order screen from said fulfillment provider when said action button is selected by said viewing device so that the viewing device will be able to place an order over the communication network directly with said fulfillment provider for goods and/or services with respect to said high resolution image stored by said fulfillment provider.

2. (Previously Presented) A method according to claim 1 wherein the service to be provided by said fulfillment provider comprises printing, e-mailing, sharing or providing a high resolution copy of said high resolution digital image.

3. (Previously Presented) A method according to claim 1 wherein said selection of said action button automatically results in printing a high resolution copy of said high resolution digital image.

4. (Previously Presented) A method according to claim 1 wherein said website and said fulfillment provider are the same site.

5. (Previously Presented) A method according to claim 1 wherein said images are published at said website in an HTML format.

6. (Previously Presented) A method according to claim 1 wherein said image is provided to said website and said service provider in a JPEG format.

7. (Previously Presented) A method according to claim 1 wherein said image is displayed at said website in a diary format.

8. (Original) A method according to claim 1 wherein software is provided on said user computer for use in creating a web log at said accessible website.

9. (Previously Presented) A method to according to claim 1 wherein a capture device automatically identifies a digital image for automatic transfer to said website and fulfillment provider.

10. (Original) A method according to claim 9 wherein said identification comprises a voice activated command with respect to said capture device.

11. (Original) A method according to claim 8 wherein said software allows appending of existing web log with new images and new log entries.

12. (Previously Presented) A computer readable medium tangibly embodying a program executable by the computer to perform method steps for publishing images at a website coupled to a communication network and for ordering goods and/or services to be provided by a fulfillment provider also coupled to the communication network with respect to images stored at said fulfillment provider, said program which when loaded and executed on the computer will cause the computer to perform said method steps, said method steps comprising:

forwarding a high resolution digital image from a network coupled user device over the communication network to said fulfillment provider, said fulfillment provider storing said high resolution digital image and associating a unique ID with said high resolution image, said unique ID identifying both a storage location of where said high

resolution image is stored and an internet address of said fulfillment provider;

receiving over the network from said fulfillment provider said unique ID associated with said high resolution image; and

forwarding over the network to said website from said user device a low resolution image copy of said high resolution image and said unique ID, said website publishing said low resolution image on the communication network along with an action button that is associated with said unique ID, wherein selection of said action button by a viewing device coupled to the communication network causes said viewing device to receive over the network an order screen from the fulfillment provider so that the viewer will be able to place an order over the network directly with said fulfillment provider for ordering goods and/or services from the fulfillment provider with respect to said high resolution image stored by said fulfillment provider.

13. (Previously Presented) The computer readable medium according to claim 12 wherein the service being provided by said service provider comprises printing, e-mailing, sharing or obtaining the high resolution copy of said image.

14. (Previously Presented) The computer readable medium according to claim 12 wherein said selection of said selection button automatically results in obtaining a hard copy print that uses the high resolution image stored at the fulfillment provider.

15. (Previously Presented) The computer readable medium according to claim 12 wherein said accessible website and fulfillment provider are the same site.

16. (Previously Presented) The computer readable medium according to claim 12 wherein said one or more images are published at said accessible website in an HTML format.

17. (Previously Presented) The computer readable medium according to claim 12 wherein said image is provided to said website and said service provider in a JPEG format.

18. (Previously Presented) The computer readable medium according to claim 12 wherein said image is displayed at said publicly accessible website in a diary format.

19. (Previously Presented) The computer readable medium according to claim 12 wherein a capture device automatically identifies a digital image for automatic transfer to said accessible website and fulfillment provider.

20. (Previously Presented) The computer readable medium according to claim 19 wherein said identification comprises a voice activated command with respect to said capture device.

21. (Canceled)

22. (Previously Presented) A method for providing image goods and/or services over a communication network, comprising the steps of:

providing a hosting website coupled to the communication network;

receiving at the hosting website a low resolution digital copy, sent over the communication network by a user device, of a high resolution digital image, the low resolution digital copy including an unique ID, the unique ID associated with both a network connected fulfillment provider's network address on the communication network and

with a storage location on a storage device at the fulfillment provider that contains the high resolution digital image; and

providing an action button on the hosting website that is associated with the fulfillment provider's network address and with the storage location, and that, when activated by a viewing device coupled to the network and accessing the hosting website, provides to the viewing device an order screen from the fulfillment provider, the order screen for placing an order over the communication network directly with said fulfillment provider for goods and/or services with respect to said high resolution digital image stored on a storage device at the fulfillment provider.

## **Appendix II - Evidence**

NONE



**Appendix III – Related Proceedings**

NONE